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REMARKS

Reconsideration and withdrawal of the restriction requirement are respectfully requested in view of the remarks herewith.

The restriction requirement called for an election between Group I, claims 1, 3 to 5 and 8 to 11 drawn to a composition comprising specific protein agents, a kit thereof and a method of preventing or treating specific conditions using the composition and Group II, claims 1 to 2 and 6 to 11 drawn to a composition comprising specific nucleic acid agents, a kit thereof and a method of preventing or treating specific conditions using the composition.

Group I is elected, with traverse.

Group I claims and Group II claims are related to each other in that the Group II claims are the DNA that encodes the specific protein composition in Group I claims, as also recognized by the Examiner (Office Action, at 2). In addition, the overlapping of claims 8 to 11 between Group I and Group II claims also evidence unity between the two Groups.

The Examiner's attention is further respectfully invited to review MPEP § 803 which lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. Second, searching the additional inventions must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ...even though it includes claims to distinct or independent inventions.” *Id.*

There has been no showing of any undue or serious burden in searching and examining both the compositions and the DNA encoding the specific protein composition in this application. Accordingly, it is further respectfully submitted that the Office Action is fatally defective and the restriction requirement cannot stand.

Therefore, it is respectfully submitted that there is no undue or serious burden in searching and examining both Groups I and II in this application.

Furthermore, 37 C.F.R. §§ 1.475, 1.499, PCT Rule 13 MPEP § 1893.03(d) and the Examples of Annex B Part 2 of the PCT Administrative Instructions (MPEP Appendix A) applies here.

In particular, the Examiner (and the Office Action) were required to explain why each Group of the various Groups allegedly lack unity with respect to each other Group, *i.e.*, why there is no single general inventive concept, specifically describing the unique special technical feature in each Group. *See MPEP § 1893.03(d).*

Applicants have the right in this application to have more than one invention searched and examined, so long as there is a linking inventive concept, *e.g.*, where there is a technical relationship between the inventions that involved at least one common or corresponding special technical feature. MPEP § 1893.03(d).

Indeed, in instructing the Examiner to look for a special technical feature, MPEP §1893.03(d) directs the Examiner to Examples 1-17 of Annex B Part 2 of the PCT Administrative Instructions (Appendix AI of the MPEP).

Example 17 of Annex B Part 2 of the PCT Administrative Instructions (Appendix AI of the MPEP) demonstrates that the restriction requirement mailed February 27, 2001 is clearly erroneous; and that the claims set forth herein have unity of invention and must be examined together.

More in particular, Example 17 of Annex B Part 2 of the PCT Administrative instructions (Appendix AI of the MPEP) provides:

Claim 1: Protein X

Claim 2: DNA sequence encoding Protein X

Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

Thus, under 37 C.F.R. §§1.475, 1.499, PCT Rule 13 MPEP § 1893.03(d) and the Examples of Annex B Part 2 of the PCT Administrative Instructions (MPEP Appendix AI), at least the claims of Group I and II should not have been separated.

Accordingly, Group I and Group II claims clearly fit within Example 17 of Annex B Part 2 of the PCT Administrative Instructions (Appendix AI of the MPEP). As the protein and DNA encoding the protein are the subject matter of these claims and Group I claims and Group II claims have unit of invention.

Therefore, claims 1 to 11 herewith have unity of invention; and it is respectfully requested that they be searched and examined together in this application. Furthermore, reconsideration and withdrawal of the restriction requirement is respectfully requested.

CONCLUSION

Restriction has been shown to be improper under MPEP § 1893.03(d) and 37 C.F.R. §§ 1.475, 1.499 such that restriction cannot be maintained.

Thus, reconsideration and withdrawal of the restriction requirement, early and favorable examination on the merits, and prompt issuance of a Notice of Allowance are earnestly solicited.

Moreover, if any issue remains as an impediment to allowance, an interview is respectfully requested; and, the Examiner is respectfully further requested to telephonically or electronically contact the undersigned to arrange a mutually convenient time and manner for such an interview.

Respectfully submitted,  
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